

DOCKET NO.: 282277US2PCT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

IN RE APPLICATION OF:  
Yoshikatsu TAJIMA, et al.

GROUP: 2617

SERIAL NO: 10/562,123

EXAMINER: CHAMBERS, TANGELA

FILED: December 23, 2005

FOR: TRANSMITTER APPARATUS, RECEIVER APPARATUS AND RADIO  
COMMUNICATION APPARATUS

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

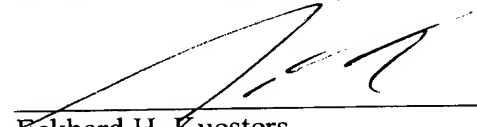
This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s). No more than five (5) pages are provided.

I am the attorney or agent of record.

Respectfully Submitted,

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MAIER & NEUSTADT, P.C.

  
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IN RE APPLICATION OF :  
YOSHIKATSU TAJIMA, ET AL. : EXAMINER: CHAMBERS, T.  
SERIAL NO: 10/562,123 :  
FILED: DECEMBER 23, 2005 : GROUP ART UNIT: 2617  
FOR: TRANSMITTER APPARATUS, :  
RECEIVER APPARATUS AND RADIO  
COMMUNICATION APPARATUS

REMARKS ACCOMPANYING  
PRE-APPEAL BRIEF REQUEST FOR REVIEW

COMMISSIONER FOR PATENTS  
ALEXANDRIA, VIRGINIA 22313

SIR:

Applicants respectfully request that a Pre-Appeal Brief Conference be initiated in accordance with the pilot program outlined in the Official Gazette Notice of July 12, 2005.

**FAILURE TO PRESENT A *PRIMA FACIE* CASE OF ANTICIPATION**

Claims 1-3, 5, and 6 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Gan et al. (Gan) (US 2002/0136268). This rejection is respectfully traversed.

The present invention as recited in Claim 1 for example, recites at the last line, “each radio frame containing the channel information.” This is a novel feature of the invention and not disclosed or suggested in Gan.

To the contrary of conventional systems including Gan et al., claim 1 recites that the transmitter transmits each radio frame containing the channel information. Gan et al. does not have each radio frame transmitting the channel information but it is explained in Gan at p. 10, section IV, that there is special packet that identifies the selected set of good

communication channels in the payload. Thus, contrary to claim 1 which transmits each radio frame containing the channel information, it appears in Gan that only the “special packet” which is the “good channel packet 400” of Figure 4 identifies the selective set of good communication channels. Thus, the limitation of the transmitter transmits each radio frame containing the channel information is neither disclosed or suggested in Gan. While the “special packet” which is referred to as the good channel packet 400 may contain information of good communication channels, none of the other packets of Gan et al. disclose the transmission of channel information, as claimed.

The outstanding Office Action at the top of page 5 indicates that the feature of “a transmission applying-channel notifying unit that inserts channel information for identifying a channel into each radio frame” is found in Gan at Fig. 1B, p. 4, paragraph [0060], p. 5, paragraphs [0071] and [0076], and p. 10, paragraph [0143]. The outstanding Office Action states that Gan teaches determining channel information for insertion into a radio frame (packet) based on a schedule, periodic, or as necessary. However, Gan certainly does not disclose or suggest inserting channel information for identifying a channel into each radio frame as claimed.

Because Gan generates a “special packet” that identifies the selected set of good communication channels in the payload, it is not possible for every packet to be the “special packet” as this would prevent or limit the transmission of ordinary data in the payload. Because a “special packet” is used, it would not be obvious to have every packet as the special packet in Gan.

Further, the outstanding Office Action indicates at the bottom portion of p. 3 that “It is inherent from the disclosure that channel information could be inserted into each frame and transmitted.” However, this assertion is not consistent with the law of inherency and the law of inherency permits a claim limitation to be considered inherent in the prior art if it is

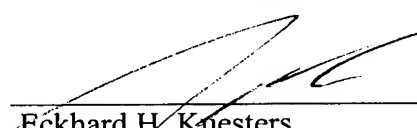
necessarily present in the prior art, not merely probably or possibly present. *Rosco v. Mirror Light*, 304 F.3d 1373, 1380 (Fed. Cir. 2002). Just because the channel information *could* be inserted into each frame doesn't mean that it is inherent or actually disclosed that the channel information is inserted into each frame.

Accordingly, the rejection under 35 U.S.C. § 102 of claim 1 is respectfully requested to be withdrawn.

CONCLUSION

Based on this clear legal deficiency in the above-noted rejection, Applicants respectfully request that prosecution be re-opened as the current grounds of rejection have not been clearly developed to such an extent that the Applicants can readily judge the Examiner's position or the advisability of preparing a traditional Appeal Brief.

Respectfully submitted,  
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